

REMARKS

I. Application Status

Claims 1-3, 6, 7, 10, 11, 16, 17, and 19-23 are currently pending the Subject Application. Claims 1, 6, 7, 10, 16, 17, and 19 have been currently amended. Claims 5 and 15 have been canceled without disclaimer or prejudice. Applicants reserve the right to represent Claims 5 and 15 in the Subject Application or in continuing applications. Claims 20-23 are new. No new matter has been added.

In the Office Action, Claims 1-3, 5-7, 10, 11, 15-17, and 19 have been rejected under 35 U.S.C. § 112, second paragraph and under 35 U.S.C. § 103(a). In view of the cancellation of Claims 5 and 15, Applicants respectfully submit that the rejections thereof are mooted. Applicants respectfully traverse all of the rejections in the Office Action at least in view of the foregoing amendments and the following remarks. Applicants also respectfully request reconsideration and allowance of all pending claims.

II. Claim Language Interpretation

Applicants do not necessarily agree with the Office Action's claim language interpretation on pages 2 and 3 of the Office Action and respectfully submit that other claim language interpretations are possible in view of the Subject Application's disclosure and claim scope.

III. Claim Rejections

35 U.S.C. § 112, Second Paragraph

Claims 1-3, 5-7, 10, 11, 15-17, and 19 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent Claims 1 and 10 have been currently amended and now do not recite a "macroporous storage element" and, therefore, Applicants respectfully submit that the Office Action's 35 U.S.C. § 112, second paragraph rejection of all pending claims is respectfully mooted. However, Applicants expressly reserve the right to address such a rejection at a later

time and to use the term “macroporous storage element” in a claim of the Subject Application or in continuing applications. Applicants further respectfully submit that use of such a term is proper and definite.

35 U.S.C. § 103(a)

Claims 1-3, 5-7, 10, 11, 15-17, and 19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (U.S. Pat. No. 5,281,208) hereafter Thompson ‘208 (and thereby, by incorporation, Thompson (U.S. Pat. No. 3,929,135) hereafter Thompson ‘135), Kimberly-Clark EP (EP 0215417) hereafter EP ‘417, Ahr et al. (U.S. Pat. No. 4,463,045) hereafter Ahr ‘045 (and thereby, by incorporation, Radel et al. (U.S. Pat. No. 4,342,314) hereafter Radel ‘314, Moore et al. (U.S. Pat. No. 4,898,642) hereafter Moore ‘642, and Lash et al. (U.S. Pat. No. 4,935,022) hereafter Lash ‘022).

It is Office policy to follow *Graham v. John Deere Co.*, 383 U.S. 1; 148 U.S.P.Q. 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. § 103. See *MPEP* § 2141. A determination of obviousness under § 103 requires the determination of the following factual inquiries: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations, if any. Further, “*all words* in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970), see also, *MPEP* §2143.03 (emphasis added). Further still, in formulating a rejection under § 103(a), the Office must identify in an Office Action a rational basis why a person of ordinary skill in the art would have combined or modified the prior art elements in the manner claimed. See *MPEP* § 2141; *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418; 82 U.S.P.Q.2d 1385 (2007) (hereinafter “*KSR*”) (a patent examiner must provide “an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate this review, this analysis *should be made explicit*.” (Emphasis added.); *In re Kahn*, 441 F.3d 977, 988; 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006) (cited with approval in *KSR*) (“[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness.”)

In *KSR*, all elements of the claims were present in the prior art. In discussing the District Court’s analysis, the Supreme Court in *KSR* stated:

Following *Graham*’s direction, the court compared the teachings of the prior art to the claims of Engelgau. It found “little difference.” 298 F.2d at 590. Asano taught everything contained in claim 4 except the use of a sensor to detect the pedal’s position and transmit it to the computer controlling the throttle. That additional aspect was revealed in sources such as the ‘068 patent and the sensors used by Chevrolet.

As such, the Supreme Court in *KSR* only considered what analysis was proper in making a combination of known prior art elements (i.e., all elements were provided in the prior art). The *KSR* Court did not overrule the “all elements” rule in a 35 U.S.C. §103 context. Therefore, in order to establish a *prima facie* case of obviousness and make a legally sufficient obviousness rejection, an Examiner still has the burden of establishing that all elements of a claim are found in the prior art.

Further, in two recent post-*KSR* cases, the United States Court of Appeals for the Federal Circuit applied the *all elements rule* when considering obviousness and, only after the all elements rule was satisfied, determined if there was a motivation to combine the known prior art elements using the analysis set forth in *KSR*. See *Ball Aerosol and Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984; 89 U.S.P.Q.2d 1870 (2009) and *Fresenius USA, Inc. v. Baxter International, Inc.*, 2009 U.S. App. LEXIS 20155; 92 U.S.P.Q.2d 1163 (Fed. Cir. 2009). Accordingly, a legally sufficient examination of the pending claims of the Subject Application requires that the Examiner first locate *all of the elements* in the prior art and then, only if all elements are located, conduct an analysis to determine if the known elements can legally be combined using the guidelines provided by *KSR*. Further, it remains appropriate for a post-*KSR* court considering obviousness to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *Fresenius USA, Inc. v. Baxter International, Inc.*, 2009 U.S. App. LEXIS 20155; 92 U.S.P.Q. 2D 1163 (Fed. Cir. 2009). In a recent case, the Federal Circuit stated that “[a] patent composed of several elements is not proved obvious merely by demonstrating that *each of its elements* was, independently, known in the

prior art.” *In re Richard P. Mettke*, 570 F.3d 1356, 1360 (Fed. Cir. 2009) citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. at 418 (emphasis added). Additionally, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698 (Fed. Cir. 1983); and *MPEP* § 2141.02(I).

Applicants respectfully submit that the references cited in the Office Action, either alone or in combination, do not disclose or suggest all of the elements of Independent Claims 1 and 10, as amended. Applicants further respectfully submit that the Office Action has not provided legally sufficient apparent reasons to combine the references cited in the Office Action.

Independent Claim 1, as amended, recites:

A disposable absorbent article for wearing on or about a lower torso of a wearer for receiving bodily exudates, the disposable absorbent article comprising:
a topsheet;
a backsheet;
an absorbent core disposed between at least a portion of the topsheet and the backsheet;
an acceptance element, wherein the acceptance element comprises one or more apertures each having an effective aperture size of between about 0.2 square mm to about 25 square mm;
a fecal storage element disposed between at least a portion of the acceptance element and the absorbent core, wherein the fecal storage element has a compressive resistance of at least about 70%, wherein the fecal storage element comprises a macro-particulate structure comprising a multiplicity of particles, and wherein the acceptance element is disposed between at least a portion of the topsheet and a portion of the fecal storage element; and
an immobilization element configured to retain bodily exudates;
wherein the topsheet, the backsheet, the absorbent core, the acceptance element, and the fecal storage element are all separate elements from each other that are joined to define the article.

Independent Claim 10, as amended, recites:

A disposable absorbent article for wearing on or about a lower torso of a wearer for receiving bodily exudates, the disposable absorbent article comprising:
a liquid pervious topsheet;
a liquid impervious backsheet;
an absorbent core disposed between at least a portion of the liquid pervious topsheet and the liquid impervious backsheet,
an acceptance element wherein the acceptance element has an effective open area of at least 30%;
a fecal storage element disposed between at least a portion of the acceptance element and the absorbent core, wherein the fecal storage element has a compressive resistance of at least about 70%, wherein the fecal storage element comprises a macro-particulate structure comprising a multiplicity of particles, and wherein the acceptance element is disposed between at least a portion of the topsheet and a portion of the fecal storage element; and
an immobilization element;
wherein the topsheet, the backsheet, the absorbent core, the acceptance element, the immobilization element, and the fecal storage element are all separate elements from each other that are joined to define the article.

Applicants respectfully submit that none of the references cited in the Office Action, either alone or in combination, disclose or suggest *all of the elements* of Independent Claims 1 and 10. In fact, the references cited in the Office Action do not disclose or suggest a disposable absorbent article comprising: (1) a topsheet; (2) a backsheet; (3) an absorbent core; (4) an acceptance element; (5) a fecal storage element; and (6) an immobilization element, especially such a disposable absorbent article having the features recited in Independent Claims 1 and 10. As some examples, the references do not disclose or suggest “a fecal storage element disposed between at least a portion of the acceptance element and the absorbent core,” “an acceptance element is disposed between at least a portion of the topsheet and a portion of the fecal storage element,” and “the fecal storage element comprises a macro-particulate structure comprising a multiplicity of particles.” At least in view of the foregoing, the Office Action has *not* provided *all elements* of Independent Claims 1 and 10.

Further to the above, Independent Claim 1 recites, in part, "an acceptance element, wherein the acceptance element comprises one or more apertures each having an effective aperture size of between about 0.2 square mm to about 25 square mm." The Office Action states, on pages 6 and 7, that "the *topsheet* of Thompson et al comprises or obviously comprises (Note MPEP 2131.03 and 2144.05) at least one aperture having an area of between 0.2 sq. mm to 25 sq. mm, e.g., apertures of equal size of such area, for enhanced acceptance of fluid." (Emphasis added.) Independent Claim 1, however, recites that the *acceptance element* and *not the topsheet* comprises the above-referenced features. Furthermore, Independent Claim 1 specifically claims a "topsheet" as another element of the claim. As a result, the Office Action has *not* provided *all elements* of Independent Claim 1 because the *topsheet* referenced by the Office Action is respectfully *not the same* as the claimed *acceptance element*.

Additionally, neither Thompson '208 nor any other references cited in the Office Action disclose or suggest a fecal storage element, as recited in Independent Claims 1 and 10. Thompson '208, referring to Fig. 7, instead discloses a topsheet 9, a secondary topsheet 10, a fluid retaining core 11, and a fluid impervious backsheets 12. The purpose of the secondary topsheet 10 comprising capillary channel fibers therein is to promote fluid flow into the fluid retaining core 11 (i.e., absorbent core). See Thompson '208, col. 7, lines 57-62 and col. 8, lines 53-65. Figs. 8A and 8B of Thompson '208 comprise a similar configuration. Applicants respectfully note that the secondary topsheets of Thompson '208 are *simply not, and do not function as*, fecal storage elements disposed between at least a portion of the acceptance element and the absorbent core, wherein the fecal storage elements have a compressive resistance of at least about 70%, and wherein the fecal storage elements comprises a macro-particulate structure comprising a multiplicity of particles, as recited in Independent Claims 1 and 10. As a result, the Office Action has *not* provided *all elements* of Independent Claims 1 and 10, as amended.

Applicants respectfully submit that the Office Action's apparent reasons for combining the various references cited in the Office Action are legally insufficient. The Office Action states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a compressive resistance of at least about 70% on the Thompson et al device *since it has been held that where the general conditions of a*

claim are disclosed in the prior art as in the instant case, i.e. see discussion supra, *it is not inventive to discover the optimum or workable ranges by routine experimentation*. In re Aller, 105 USPQ 233. (Office Action, page 6, emphasis added).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an effective aperture size as claimed on the Thompson et al device, if not already, *since it has been held that where the general conditions of a claim are disclosed in the prior art as in the instant case*, i.e. see discussion supra, *it is not inventive to discover the optimum or workable ranges by routine experimentation*. In re Aller, 105 USPQ 233. (Office Action, page 7, emphasis added).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a storage element as claimed on the Thompson et al device, if not already, *since it has been held that where the general conditions of a claim are disclosed in the prior art as in the instant case*, i.e. see discussion supra, *it is not inventive to discover the optimum or workable ranges*, i.e. the claimed range of viscosity, *by routine experimentation*. In re Aller, 105 USPQ 233. (Office Action, page 8, emphasis added).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a storage element as claimed on the Thompson et al device, if not already, *since it has been held that where the general conditions of a claim are disclosed in the prior art as in the instant case*, i.e. see discussion supra, *it is not inventive to discover the optimum or workable ranges*, i.e. the claimed "macroporosity" as best understood, *by routine experimentation*. In re Aller, 105 USPQ 233. (Office Action, page 9, emphasis added).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an effective open area of at least about 30% on the Thompson et al device, if not already, *since it has been held that where the general conditions of a claim are disclosed in the prior art as in the instant case*, i.e. see discussion supra, *it is not inventive to discover the optimum or workable ranges by routine experimentation*. In re Aller, 105 USPQ 233. (Office Action, page 11, emphasis added).

Applicants respectfully submit that the above-referenced “apparent reasons” provided in the Office Action are legally insufficient under *KSR*. First, the Office Action makes no explicit analysis of *why* someone of ordinary skill in the art would combine the references cited in the Office Action in the fashion combined by the Examiner, as specifically required by *KSR*. Second, “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) *In re Kahn*, 441 F.3d 977, 988; 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006) (cited with approval in *KSR*).

The Office Action’s “apparent reasons” rely heavily on *In re Aller* in an attempt to render obvious the various features recited in the claims. 220 F.2d 454; 105 U.S.P.Q. 233 (CCPA 1955). However, the references cited in the Office Action do not disclose or suggest such features. In fact, most of the Office Action’s arguments merely argue that such features and/or parameters are inherent in the teachings of the references cited in the Office Action. Such arguments are respectfully not sufficient to sustain an obviousness rejection under *KSR*. Further, *In re Aller* stands for the proposition that “[w]here the general conditions of a claim *are disclosed* in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” 220 F.2d 454, 456, 105 U.S.P.Q. 233, 235 (CCPA 1955) (Emphasis added). In this instance, the Office Action has failed to establish that the general conditions of the pending claims are disclosed or suggested in the references cited in the Office Action and, therefore, Applicants respectfully submit that *In re Aller* is not applicable to the claims of the Subject Application. In addition, the “apparent reasons” of the Office Action acknowledge, at least to some extent, that the prior art does not disclose or suggest all elements of Independent Claims 1 and 10 and merely state that such claimed features would be obvious.

In view of the foregoing, Applicants respectfully submit that the Office Action has not established a legally sufficient case of obviousness under 35 U.S.C. § 103(a) and *KSR*, in that (1) the Office Action does not provide all elements of Independent Claims 1 and 10, and (2) the Office Action does not provide legally sufficient apparent reasons to combine the references cited in the Office Action. Therefore, Applicants respectfully request withdraw of all of the rejections in the Office Action and allowance of all pending claims.

IV. New claims 20-23

Applicants respectfully submit that new claims 20-23 are patentable over the references cited in the Office Action. New claims 20 and 22 both recite that “the immobilization element is disposed between at least a portion of the fecal storage element and the absorbent core” and new claims 21 and 23 both recited that “the immobilization element is configured to retain greater than about 7.5 g of bodily exudates.” Neither of these recitations are disclosed or suggested by the references cited in the Office Action. Therefore, Applicants respectfully request consideration and allowance of new claims 20-23.

V. The Subject Application Requires SPE Review and Should be Made Special

MPEP § 707.02 provides that:

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory patent examiners are expected to personally check on the pendency of every application which is up *for the third or subsequent Office action* with a view to finally concluding its prosecution.

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered “*special*” by the examiner. (Emphasis Added).

In view of the express direction of the *MPEP*, Applicants hereby request review of the Subject Application by the Examiner’s a supervisory patent examiner and that the Subject Application be made special. The Subject Application has been pending since January 15, 2004, and has now received twelve (12) office actions. Applicants have also filed seven (7) Requests for Continued Examination in the Subject Application.

VI. Reservation of Arguments

Applicants do not otherwise concede, however, the correctness of the Office Action’s

rejections with respect to any of the claims in the Subject Application. Accordingly, Applicants hereby reserve the right to make additional arguments as may be necessary to further distinguish the claims from the cited references based on additional features recited in the claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the foregoing amendments and the remarks.

VII. Conclusion

Applicants respectfully submit that the claims presented in the Subject Application are in condition for allowance. Applicants' present Amendment should not in any way be taken as acquiescence to any of the specific assertions, statements, etc., presented in the Office Action not explicitly addressed herein. Applicants reserve the right to specifically address all such assertions and statements in subsequent responses. If the Examiner has any remaining concerns, the Examiner is invited to contact the undersigned at the telephone number set forth below so that such concerns may be expeditiously addressed.

Respectfully submitted,

4/21/10
Date

Christian M. Best
Christian M. Best
Registration No. 49,092

K&L Gates LLP
K&L Gates Center
210 Sixth Avenue
Pittsburgh, Pennsylvania 15222-2613
Tel.: 412.355.8636
Fax: 412.355.6501

Attorneys for Applicants